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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/707,140 | 11/06/2000 | Outi Aho | 460-009944-US(PAR) | 8800 |
| 2512 | 7590 | 09/17/2007 | | |
| PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824 | | | EXAMINER VU, THONG H | |
| | | | ART UNIT 2616 | PAPER NUMBER |
| | | | MAIL DATE 09/17/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary

Application No.

09/707,140

Applicant(s)

AHO, OUTI

Examiner

Thong H. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/01; 1/01
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

1. Claims 1-52 are pending.
2. Prosecution on the merits of this application is reopened on claims 1-52 considered unpatentable for the reasons indicated below:
 - The Double Patenting rejection.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-52 are rejected on the ground of nonstatutory double patenting over claims 1-13 of U. S. Patent No. 6,678,361 B2 ('361) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

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|---|---|
| <p>(‘361) 1. A method for delivering multimedia messages in a communication network comprising a multimedia messaging service center (MMSC) connected to a Support Node (SN) capable of communicating with Protocol Data Units (PDU), the Support Node being further accessible to a plurality of mobile terminals for transmitting multimedia messages comprising one or more segments, said method comprising the steps of</p> | <p>(Application) 1. A method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server; the method comprising the steps of:</p> |
| <p>the MMSC receiving a multimedia message addressed to a particular mobile terminal;</p> | <p>- Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component, said multimedia message comprising at least one multimedia component</p> |
| <p>activating a context for data transfer between the addressed mobile terminal and the support node and submitting capability information concerning the capabilities (CAP) of the addressed mobile terminal (MS) from said addressed mobile terminal to said multimedia messaging service center (MMSC) with Protocol Data Units (PDU), the capability information being capable of indicating codecs supported by said terminal;</p> | <p>- Storing information on at least one property of the wireless terminal in the server,</p> |
| <p>the MMSC sending a multimedia message notification concerning the multimedia message to the addressed mobile terminal to indicate the presence of the multimedia message; the MMSC modifying the multimedia message according to the capability information; the MMSC sending the modified multimedia message to the addressed mobile terminal via the support node; and the addressed mobile terminal sending</p> | <p>characterized in that the method further comprises <u>determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal</u>, wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal.</p> |

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| updated capability information to the MMSC upon the occurrence of a predetermined condition. | |
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Application, claim 1, discloses "Receiving and storing a multimedia message" and "wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal." were interpreted as sending modified message; and "determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal." wherein the "determining" which is broadly enough to read on notifying or modifying/updating the multimedia message, etc.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See also MPEP § 804.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong H. Vu whose telephone number is 571-272-3904. The examiner can normally be reached on 6:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Lynn Feild* can be reached on 571-272-2092. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thong Vu
Primary Examiner